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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/302,024	04/29/99	HODGSON J	P31353-

HM12/0218

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EXAMINER	
KERR,K	
ART UNIT	**PAPER NUMBER**
1652	7

DATE MAILED: 02/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/302,024	Applicant(s) Hodgson et al.
	Examiner Kathleen Kerr	Group Art Unit 1652

☒ Responsive to communication(s) filed on *2/28/99*

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *1* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *13, 14, and 16-19* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *13, 14, and 16-19* are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claims 13-14 and 16-19 are pending in the instant Application filed as a divisional of 08/785,455, with a preliminary amendment.

Restriction

1. Restriction to one of the following five inventions is required under 35 U.S.C. 121:

   I. Claims 13-14, drawn to polypeptides (methionyl-tRNA synthetase enzymes), classified in class 435, subclass 183.

   II. Claim 16, drawn to antagonists, classified in class 514, subclass 12.

   III. Claim 17, drawn to methods of treatment using a methionyl-tRNA synthetase polypeptide, classified in class 424, subclass 94.5.

   IV. Claim 18, drawn to methods of treatment using DNA, classified in class 514, subclass 44.

   V. Claim 19, drawn to methods of treatment using antagonists, classified in class 514, subclass 12.

2. The inventions are distinct, each from the other because of the following reasons:

Group I, drawn to polypeptides, is related to Group II, drawn to antagonists, because the polypeptides are blocked by the antagonists. While antagonists are used to affect the enzymatic activity of the polypeptides, these compounds may also be useful in affecting other enzymes. Additionally, the polypeptides are useful in the absence of antagonists, such as in *in vitro* enzymatic activity assays including substrates alone. Furthermore, polypeptides and antagonists are wholly different entities with different chemical compositions and distinct functions as evidenced by the distinct class/subclass classifications of these groups. Therefore, Group I is patentably distinct from Group II.

Group I, drawn to polypeptides, is related to Group III, drawn to methods of treatment involving administering polypeptides, as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of Group I may be used in a materially different process of using that product, such as in *in vitro* assays for testing its enzymatic activity, as opposed to the Group III methods of treatment using the polypeptides in *in vivo* experiments. Therefore, Group I is patentably distinct from Group III.

Group I, drawn to polypeptides, is related to Group IV, drawn to methods of treatment involving administering DNA encoding said polypeptides, as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the

process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of Group I may be used in a materially different process of using that product, such as in *in vitro* assays for testing its enzymatic activity, as opposed to the Group IV methods of treatment using DNA to express the polypeptides in *in vivo* experiments. Therefore, Group I is patentably distinct from Group IV.

Group I, drawn to polypeptides, is related to Group V, drawn to methods of treatment to inhibit polypeptides using antagonists, as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptides of Group I may be used in a materially different process of using that product, such as *in vitro* assays for testing its enzymatic activity, as opposed to the *in vivo* treatment methods of Group V. Therefore, Group I is patentably distinct from Groups V.

Group II, drawn to antagonists, and Groups III and IV, drawn to methods of treatment using polypeptides and methods of treatment using DNA, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the antagonists are not disclosed as capable of use as a reagent in the methods

of treatment administering either polypeptides or DNA. Furthermore, the antagonists are used to block enzymatic activity of the polypeptides while the treatments using the polypeptides or the DNA expressing the polypeptides is for the purpose of enhancing said activity. Therefore, Group II is patentably distinct from Groups III and IV.

Group II, drawn to antagonists, and Group V, drawn to methods of treatment using antagonists, are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the antagonists can be used in a materially different process of using the product, such as in *in vitro* enzyme activity assays involving inhibitors. Therefore, Groups II and V are patentably distinct.

Group III, drawn to methods of treatment using polypeptides, and Group IV, drawn to methods of treatment using DNA to express said polypeptides, are related by virtue of the polypeptides. While these methods of treatment are for similar individuals to produce similar effects, these methods use wholly different process steps and reagents, most particularly either a polypeptide or DNA, as evidenced by their distinct class/subclass classifications. Therefore, Groups III and IV are patentably distinct.

Group III, drawn to methods of treatment using polypeptides, and Group V, drawn to methods of treatment using antagonists, are unrelated. Inventions are unrelated if it can be shown

that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the methods of treatment, using either polypeptides or antagonists, are not disclosed as capable of use together. Furthermore, these methods use wholly different process steps and reagents, most particularly either a polypeptide or an antagonist, to produce wholly different effects. Therefore, Groups III and V are patentably distinct.

Group IV, drawn to methods of treatment using DNA, and Group V, drawn to methods of treatment using antagonists, are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the methods of treatment, using either DNA or antagonists, are not disclosed as capable of use together. Furthermore, these methods use wholly different process steps and reagents, most particularly either DNA or an antagonist, to produce wholly different effects. Therefore, Groups IV and V are patentably distinct.

Election

3. A telephone call was made to Mr. Allen Bloom on February 15, 2000 to request an oral election to the above restriction requirement but did not result in an election being made.

Applicants are advised that the reply to this requirement MUST include an election of the invention to be examined, even though the requirement be traversed (37 CFR 1.143).

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Sequence Compliance

4. In applicants' transmittal letter, the instant application refers to the use of the identical computer-readable form filed in Application No.08/785,455, filed 1/17/97, as the computer readable (CRF) form for the instant application. To process such a request, an express transfer of the CRF must be requested. Applicants are required to file a Request to Transfer to transfer the CRF from Application No. 08/785,455, filed 1/17/97, to the instant application; such a request will be considered without a fee.

Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Dr. Kathleen M. Kerr whose telephone number is (703) 305-1229. The Examiner can normally be reached on Monday to Friday from 8:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Ponnathapura Achutamurthy, can be reached on (703) 308-3804. The fax phone number for this Group is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

KMK

February 16, 2000